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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,153	11/13/2001	Shinichi Takagi	019519-312	6439

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BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
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EXAMINER
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CLARK, SHEILA V

ART UNIT	PAPER NUMBER
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2823

NOTIFICATION DATE	DELIVERY MODE
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01/19/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/987,153	<b>Applicant(s)</b> TAKAGI ET AL.	
	<b>Examiner</b> S. V. Clark	<b>Art Unit</b> 2823	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Remand of 9/25/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47,51-54 and 56-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47,51-54 and 56-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **Detailed Action**

### Opening Comments

In light of the issues pointed out in the Remand order from the Board of Patent Appeals and Interferences, the present application has been reopened. Additionally, it is noted for future reference, it is herein indicated that the Appeal Brief of 12/10/08 is defective for two issues. The first issue relates to the defective declaration and the requirement for supplemental reissue declarations as indicated in the remand order. Secondly, the appendix of the Brief submitted on 12/10/08 was also defective as the new claims required underlining.

The prosecution of this application has been reopened to note the requirement of a supplemental reissue declaration and to clarify the status of original claims 1-10.

### Claim Rejections

Claims 1-47, 51-54, 56-62 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue,

which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

All independent reissue claims 1, 7, 8, 11, 16, 21, 22, 24, 25, 27, 28, 30, 33, 35, 36, 38, 40, 42, 45, 51, 52, 54, 55, 59, 60, 61 contain recapture issues whereby said claims fail to contain subject matter surrendered in the original application. Claim language similar to “wherein said level difference serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other” appears in every patented independent claim. Applicant in the amendment filed 6-15-1999 presented arguments relative to the level difference allowing a clearance so to avoid the capillary flow of solder which caused short circuiting as an essential feature regarding the patentability of this invention and whereby this feature was therefore added to obtain allowance of the original patent. This feature appears relates to subject matter previously surrendered in the original application and must be included in the reissue claims.

The MPEP 1412.02 states that, “for example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted

limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application” see 142 F.3d at 1482,46 USPQ2d at 1649.

Claims 1-47, 51-54, and 56-62 are rejected as being based upon a defective declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175 and MPEP § 1414, 1414.01.

There appears to be no supplemental reissue declaration filed for certain amendments (i.e. November 13, 2001, June 11, 2007 and September 8, 2008) whereby when claims are amended or added a supplemental reissue declaration is required ( see MPEP 1414.01 and form PTO/SB/51S).

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action. A supplemental reissue declaration signed by the reissue applicant is required.

Claims 1-47, 51-54, 56-62 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. V. Clark whose telephone number is (571) 272-1725. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mathew Smith can be reached on 571 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. V. Clark/

Primary Examiner, Art Unit 2823

April 20, 2010

/Matthew S. Smith/

Supervisory Patent Examiner, Art Unit 2823